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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,236	12/05/2003	Roger Thomas	P-US-PR-1105	9203

7590 07/31/2006  
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EXAMINER

SELF, SHELLEY M

ART UNIT PAPER NUMBER

3725

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/729,236	THOMAS, ROGER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shelley Self	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/28/04;12/5/03</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “52” has been used to designate both *expulsion aperture* (pg. 5, lines 10, 13-14) and *internal wall* (pg. 5, line 22).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: *s126* (pg. 9, line 30).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 80.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *transparent window* (clm. 9), *bayonet type connector* (clm. 4) and *hoop* (clm. 13) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not

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accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

-Pg. 4, line 21, “*sidewaysly*” is unclear

-Clm. 7, lines 2-3 “*from connector*” should be –from said connector—

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No.

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10/729231 and amended claims 2-5, 8, 9 and 11-18 of co-pending application 10/729204.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both, the claims of the presently presented application and that of the co-pending application are drawn to the same scope and subject matter. For example, claim 1 of the presently presented application recites a receptacle and a cap; claim 7 of the co-pending application 10/729231 also recites a receptacle and a cap.

Accordingly the claims of the applications are not separable and instead encompass an identical scope. Claims covering the same scope should be cancelled.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 10 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the specification nor the drawings provide support for a transparent window. Further it is not clear regarding claim 10 if the cap is made of transparent material and has a

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transparent window of if the cap is merely transparent and does not have a window.

Clarification is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 4, it is not clear what a *bayonet type connector* means. Clarification is required to facilitate a clear understanding of the claimed invention and proper application of the prior art.

Regarding claim 5, the word "means" is preceded by the word(s) "biasing" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). It is unclear if 35 U.S.C. 112 6<sup>th</sup> paragraph is being invoked or not. Examiner suggests, --*means for resiliently biasing*--.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11 and 14-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Chiang (6,629,548). Chiang discloses a debris collection container (fig. 3) for a planer comprising: a receptacle (fig. 3) for storage of debris, the receptacle defining an aperture; and a cap (fig. 3) releasably attached to the receptacle for sealing the aperture of the receptacle, the cap including a connector (21) connectable to the planer and through which debris can pass from the planer into the receptacle.

With regard to claim 11, Chiang discloses the receptacle includes a deformable section (4; col. 2, lines 47-48) manipulatable between a compressed and an expanded section. Examiner notes the use of flexible plastics as a material to construct the receptacle (3, 6) lends to a deformable section.

With regard to claims 14 and 15, Chiang discloses the deformable section includes a helical spring (4) and the spring biases the deformable section into an expanded condition.

With regard to claim 16, Chiang discloses wherein the spring forms part of the wall structure of the receptacle (fig. 4)

Claims 1-3 and 6-8 is rejected under 35 U.S.C. 102(e) as being anticipated by Wang (6,712,106). Wang discloses a debris collection container (fig. 1, 2) for a planer comprising: a receptacle (5) for storage of debris, the receptacle defining an aperture; and a cap (1) releasably attached to the receptacle for sealing the aperture of the receptacle, the cap including a connector

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(10) connectable to the planer (4; fig. 2) and through which debris can pass from the planer into the receptacle.

With regard to claim 2, Wang discloses a rim (50) and the cap (1) is releasably attached to the rim (fig. 1, 2).

With regard to claim 3, Wang disclose the size of the aperture to be fixed and relatively large (fig. 1).

With regard to claim 6, Wang discloses the connector (10) integrally formed with the cap (fig. 1).

With regard to claim 7, Wang discloses the cap (1) further includes a part spherical shaped section which curves the direction of travel of debris as it passes from the connector through the part spherical section to the receptacle (figs. 1, 2).

With regard to claim 8, Wang discloses wherein the part spherical section curves entrained debris through 90°.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9 and 10 as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Van Swearingen (3,952,484). Wang does not disclose a transparent window or cap. Van Swearingen teaches in a closely related art the



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use of a cap constructed of transparent material (col. 1, lines 61-63) so as to observe cut debris as it travels from the cutting apparatus to the debris collector (fig. 1). Because both references are concerned with a similar problem, i.e. collection and storage of debris resulting from a cutting operation, it would have been obvious at the time of the invention to one having ordinary skill in the art to construct Wang's cap of transparent material or having a transparent material so as to monitor debris as it travels to the storage receptacle as taught by Van Swearingen.

Additionally claims 9 and 10 as best as can be understood and claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (6,712,106) in view of Schneider (6,520,365). With regard to claims 9 and 10, as noted above, Wang does not disclose a transparent window. It would have been obvious at the time of the invention to construct the dome shaped section of a transparent material, because it is well within the general skill of a worker in the art to select a known material on the basis for its suitability for the intended use as a matter of design choice. See *In re Leshin*, 125 USPQ 416.

Moreover, Schneider teaches in a closely related art, a receptacle for debris collection and/or storage. Schneider teaches the receptacle to be constructed from any one of various materials (col. 3, lines 12-27). Specifically, Schneider teaches the use of a netting (col. 3, line 15), Examiner notes, netting or netted fabric to be an open mesh fabric, i.e. see thru and thus transparent. Because, both Wang and Schneider are concerned with a similar problem, i.e. debris collection/storage it would have been obvious at the time of the invention to one having ordinary skill in the art to construct receptacle of transparent, netted flexible material as taught by Schneider for its transparency and ability to withstand damage.

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With regard to claim 12 and 13, Wang does not disclose a deformable section, a second rigid section, a hoop or catch. Schneider teaches a receptacle (fig. 1) having a first rigid section (14), a second rigid section (16, 28) and a deformable section (12, 18) of transparent material located between and connecting the first rigid section and the second rigid section (figs. 1, 2), the deformable section (12, 18) includes a helical spring (20) and is manipulatable between a compressed condition and an expanded condition (figs. 1, 2); wherein the first rigid section (14) defines an aperture and can be releasably attached to the second rigid section (16, 28) when the deformable section is in a compressed condition (fig. 2) and wherein the first rigid section is adjacent to the second rigid section. Schneider also teaches, a hoop/loop and catch (64, 66) included on the first and second sections (14, 16) for releasably attaching the first section (14) to the second section (16, 28).

Schneider teaches this construction of a storage/debris receptacle so as to allow efficient storage of the receptacle when not in use. Because both Wang and Schneider teach debris/storage receptacles, it would have been obvious at the time of the invention to replace Wang's receptacle (5) with a collapsible receptacle (i.e. first and second rigid sections) so as to facilitate compact and efficient storage of the receptacle when not in use as taught by Schneider.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached

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at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

July 18, 2006

